REMARKS / ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

II. Disposition of Claims

Claims 1-4, 7-11, 14-18, 21, 22, 27, and 30 are pending in this application. Claims 5, 6, 12, 13, 19, 20, 28, and 29 were cancelled in previous responses.

Claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30 stand rejected under 35 U.S.C. § 102(e). Claims 3, 4, 10, 11, 17, and 18 stand rejected under 35 U.S.C. § 103(a).

III. Remarks Regarding Claim of Priority

The Office Action states that Applicants may not claim priority to U.S. Patent Application Serial No. 10/254,268 (the "'268 Application") because this application does not disclose the concept of a gel breaker comprising a degradable acid releaser. With respect to this assertion, the Office Action states:

> It is Applicant's contention that the presently claimed invention is, in fact, properly enabled according to the requirements of 35 U.S.A. § 112, first paragraph in view of their disclosure at page 24, lines 13-21 (which, incidentally recites the same subject matter as does the passage on page 17 alluded to by the Examiner in the last correspondence). The Examiner respectfully disagrees.
>
> It can only be presumed that Applicant is referring to their statement that "slowly soluble acid-generating compounds" may be employed because "encapsulated acids" are certainly not equivalent to the acids-releasing degradable material contemplated by Applicant's claims. Even were the Examiner to concede that this recitation of a "slowly soluble acid-generating compounds" represents an enabling disclosure for the acid-releasing degradable material now claimed, there is simply no support whatsoever for the specific types of acid-generating materials set forth in each independent method-and/or composition claim. The Examiner, therefore, maintains his position that Applicant is not entitled to the benefit of the earlier filing dated associated with 10/254,268.

(Office Action at page 2.) Applicants respectfully disagree.

Applicants reiterate that the '268 Application adequately supports and enables the use of an acid-releasing degradable material to produce an acid to reduce the pH and viscosity of

a treatment fluid, as recited in Applicants' claims, in accordance with the requirements of 35 U.S.C. § 112, first paragraph. "The subject matter of the claim need not be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement" of Section 112. MANUAL OF PATENT EXAMINING PROCEDURE § 2163.02 (2006). Thus, even if the '268 Application does not explicitly contain the same terms and language used in Applicants' claims, these terms are adequately supported in that disclosure, as would be recognized by a person skilled in the art. Accordingly, Applicants respectfully request that the Examiner acknowledge the proper claim of priority for the present claims from the '268 Application.

IV. Rejections of Claims Under 35 U.S.C. § 102(e)

Claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0028976 by Philip D. Nguyen ("the Nguyen Application"). With respect to these rejections, the Office Action states:

> Claims 1-2, 7-9, 14-16, 21-22, 27, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen, U.S. Patent Application Publication no. 2005/0028976 for the reasons cited in the correspondence dated September 6, 2005.
>
> The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by and appropriate showing under 37 CFR 1.131.

(Office Action at page 3.) Applicants respectfully disagree with these rejections.

First, as discussed in Section III. above, Applicants maintain that they have properly claimed priority from U.S. Patent Application Serial No. 10/254,268, which was filed on September 25, 2002, prior to the filing date of the Nguyen Application. Therefore, the Nguyen Application does not constitute prior art to Applicants' claims.

Moreover, a rejection based on 35 U.S.C. § 102(e) may be overcome by filing a declaration under 37 C.F.R. 1.131 showing prior invention. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 706.02(b). Applicants have filed herewith a Declaration Pursuant 37 C.F.R.

§ 1.131 establishing a reduction to practice of the present invention prior to August 5, 2003, the effective date of the Nguyen Application.

Therefore, Applicants respectfully assert that the Nguyen Application should not be cited as a prior art reference against the present application, and respectfully request withdrawal of this rejection with respect to claims 1, 2, 7-9, 14-16, 21, 22, 27, and 30.

V. Rejections of Claims Under 35 U.S.C. § 103(a)

Claims 3, 4, 10, 11, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nguyen Application in view of U.S. Patent Nos. 5,813,466, 5,224,546, and/or 6,793,018. With respect to these rejections, the Office Action states:

> [Nguyen] only mentions the treating fluids, e.g. fracturing fluids and transport fluids for gravel packs, in general terms, there being no mention of the components that make up the fracturing/transport fluids themselves. Indeed, the focus of their disclosure is largely on the coated particles that are incorporated into the fluids. In the absence of any indication as to what is conventional, or even suitable, for preparing these treating fluids, one of ordinary skill would turn to the related well treatment art to ascertain what materials are typically used in this capacity.
>
> The Examiner has already cited during this prosecution several references that, likewise, are directed to well treating fluids. In all three cases, they advocate using viscous fluids comprising a crosslinked polymer. Further, in all instances, they recommend the employment of a polysaccharide such as guar gum or a cellulose derivative as the crosslinkable polymer (column 5, lines 16-33 of '018, column 3, lines 35 to 44 of '546, and column 3, lines 10-20 or '446.) Each of these documents likewise contemplate using crosslinking agents like those recited in claims 3, 10, and 17 (see column 3, lines 40-57 of '018, column 4, lines 4-8 of '546, and column 3, lines 66-67 through column 4, lines 1-46 of '466)
>
> Insofar as the invention suggested by the combination utilizes the same crosslinkable polymers and crosslinkers as are mentioned in Applicant's Specification, it is clear that the limitation of claims 4, 11, and 18 is inherently satisfied.

(Office Action at pages 3-4.) Applicants respectfully disagree with these rejections because the Nguyen Application is not available as prior art under 35 U.S.C. § 103(a).

First, Section 103(c) provides that "[s]ubject matter developed by another person, which qualifies as prior art only under [§ 102(e)] shall not preclude patentability under [§ 103(a)]

where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." 35 U.S.C. § 103(c). Because the Nguyen Application was published after the filing date of the present application it can be available as a prior art reference only under § 102(e). The present application and the Nguyen Application were, at the time the invention of present application was made, both owned by Halliburton Energy Services, Inc. As the present application was filed on or after November 29, 1999, Applicants' statement of common ownership at the time the invention of the present application was made is sufficient to remove prior art from the purview of § 103(a) since that prior art could have been prior art only under § 102(e). *See* MANUAL OF PATENT EXAMINING PROCEDURE § 706.02(l)(2). Thus, the Nguyen Application is no longer available as prior art under § 103(a) in accordance with § 103(c).

Moreover, as discussed in Section IV. above, Applicants' Declaration Pursuant 37 C.F.R. § 1.131 submitted herewith establishes a reduction to practice of the present invention prior to August 5, 2003, the effective date of the Nguyen Application, and thus the Nguyen Application is not available as prior art against Applicants' claims.

For these reasons, Applicants respectfully request the withdrawal of these rejections against claims 3, 4, 10, 11, 17, and 18.

SUMMARY AND PETITION FOR EXTENSION OF TIME OF TWO MONTHS TO FILE THIS RESPONSE

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants hereby petition under the provisions of 37 C.F.R. § 1.136(a) for a two-month extension of time to file this Response, up to and including August 6, 2006.

The Commissioner is hereby authorized to debit the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300 in the amount of $450.00 for the fee under 37 C.F.R. § 1.136(a) for the Two-Month Petition for Extension of Time to File this Response.

Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,

Robert A. Kent
Registration No. 28,626
Halliburton Energy Services, Inc.
2600 South Second Street
P.O. Drawer 1431
Duncan, OK 73536-0440
Telephone: 580-251-3125

Date: July 25, 2006